

REMARKS

The Present Claims Have Been Twice Confirmed as Allowable by the Board of Appeals

Applicants originally filed this case close to a decade ago, in 1997, and the claims have remained virtually unchanged since 1999. Applicants have twice presented this case on Appeal and have twice had the present claims confirmed as allowable by the Board. As will be discussed in greater detail below, the two Board decisions share a common theme regarding key features of the claim language that are absent from any of the art of record. In fact, the claims are presently rejected based primarily on the very reference addressed by the Board.

The present claims 1-21 were examined by the Board of Patent Appeals and Interferences (the "Board") in two decisions – the original Decision on Appeal mailed April 30, 2003 (the "First Board Decision") and the most recent Decision on Appeal mailed February 24, 2006 (the "Second Board Decision"). In both of these Decisions on Appeal, the Board found the present claims allowable over the cited references. In the Second Board Decision, the Board even found the claims allowable over the primary reference used in all of the current rejections. None of the other cited references cure the deficiencies found by the Board.

Consider Applicants' Claim 1, which has been twice reviewed and held allowable by the Board, and which recites:

A video surveillance system, comprising:
a client operable to perform a financial transaction, the client further operable to generate data from the financial transaction, the client having a camera operable to generate video of the financial transaction, the client operable to transmit the data and video using a communications network;
and
a server coupled to the client using the communications network, the server operable to receive the data and video from the client and to display the video and data in real-time.

In finding this claim allowable in the First Board Decision, the Board acknowledged that the cited reference showed both video and financial data being created at an ATM, but made clear that this was not sufficient to maintain the rejection. The Board held that: "Although [the cited reference] undoubtedly generates financial data at the ATM along with a

video of the financial transaction, nothing in the record before us indicates that such financial data is transmitted with the video from the end station location of the ATM to the center station via the ISDN network.” First Board Decision, at 3-4. The Board in the Second Board Decision echoed this rationale, holding that: “[The cited reference] is completely silent as to the video and data being sent or displayed in real time at the server computer.” Second Board Decision, at 4.

None of the presently cited references show the claimed aspects that the Board found to place the claims in condition for allowance. In fact, none of the cited references even hint at any generation and real-time transmission of video and data for a financial transaction, let alone the specific aspects required by the claims.

Claim Rejections under 35 U.S.C. § 103

Claims 1-21 are Patentable Over the Proposed Schwab-Bellinger-Grant Combination

The Examiner rejects Claims 1-21 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,973,731 to Schwab (“*Schwab*”) in view of U.S. Patent No. 5,870,725 to Bellinger, et al. (“*Bellinger*”) and further in view of U.S. Patent No. 4,660,168 to Grant et al. (“*Grant*”).

Applicants respectfully submit that the rejection based on the proposed *Schwab-Bellinger-Grant* combination fails for two reasons – (1) the proposed combination fails to teach or suggest all elements of the claims and (2) there is no motivation to combine the references.

The Proposed *Schwab-Bellinger-Grant* Combination Fails to Teach or Suggest All Claim Elements

As noted above, none of the cited references even hint at any generation and real-time transmission of video and data for a financial transaction, let alone the specific aspects required by the claims. In fact, the reference that the Office Action relies on as teaching these aspects, *Bellinger*, expressly teaches away from this type of operation.

In general, *Bellinger* discloses a system for imaging large batches of checks. See *Bellinger*, at Abstract. *Bellinger* discusses the imaging as a back-end process that occurs

during a bank's reconciliation processing. *Id.* at column 11, lines 40-64. *Bellinger* never mentions or even hints at any capture of video of a financial transaction, let alone real-time capture and transmission of video data. The only image capturing capability described by *Bellinger* is that of a camera for rapidly imaging checks. *Id.* at column 3, lines 48-51. *Bellinger* makes clear, however, that this imaging takes place well after any associated financial transaction actually occurs, as *Bellinger* states in its Abstract that its system captures images of *cleared* checks. *Id.* at Abstract lines 2-3.

Therefore, *Bellinger* simply cannot teach or suggest a system that generates, transmits, and displays, in real-time, video and data for a financial transaction. Moreover, *Bellinger* does not teach or suggest Claim 1's specific requirements of: a client that "generate[s] data [and] video of [a] financial transaction [and] transmit[s] the data and video using a communications network" along with a server that "receive[s] [and] display[s] the video and data in real-time." By teaching that imaging of checks takes place in an end-of-cycle, batch processing system, *Bellinger* actually teaches away from any of these claimed aspects, given that back-end check imaging is in no way generating and displaying real-time video and data of a financial transaction.

Similarly, the other cited references, *Schwab* and *Grant*, do not teach or suggest these aspects. *Schwab* was expressly addressed by the Board, and the Board found that *Schwab* did not teach these aspects. Second Board Decision, at 4. Likewise, *Grant* in no way contemplates any generation and transmission of real-time video from a client to a server. In fact, *Grant* barely even touches on the ability to take pictures at an ATM, addressing this only in Figure 2 and the corresponding text at column 7, lines 61-64. Specifically, In Figure 2, *Grant* includes an "external camera option 112" box, and in the corresponding text, *Grant* makes its only mention of this element, stating: "The option subsystem controller 102 is connected to a optional depository 108, a night drop box 110 and an external camera option 112." *Grant*, column 7, lines 61-64. In mentioning this camera, *Grant* does not distinguish whether it is a still camera or has video capture capabilities. Thus *Grant* does not even expressly contemplate providing any video capability, let alone the advanced capabilities required by Applicants' claims.

Applicants thus respectfully submit that the proposed *Schwab-Bellinger-Grant* combination, even if proper, fails to teach or suggest all aspects of Applicants' claims. Therefore, Applicants respectfully request reconsideration and full allowance of the claims.

**There is No Teaching or Suggestion Supporting
the Combination or Modification of *Schwab, Bellinger* and *Grant***

Applicants submit that there is no teaching, suggestion, or motivation to combine or modify the teachings of *Schwab, Bellinger*, and *Grant* either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." M.P.E.P. § 2143.01. The factual inquiry whether to combine references must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52 (Fed. Cir. 2001). This factual question cannot be resolved on subjective belief and unknown authority, but must be based on objective evidence of record. *See In re Lee*, at 277 F.3d 1338, 1343-44 (Fed. Cir. 2002).

Nothing in *Schwab, Bellinger*, or *Grant* remotely suggests or motivates the proposed combination. *Schwab* discloses a system for secure identification of items or individuals taking part in transactions. *See Schwab*, at column 1, lines 9-14. *Schwab* proposes a central database of pictures that can be used for later identification of individuals or items. *Id.*, at column 1, lines 45. At the time of a transaction, a picture can be downloaded from the central server and then compared with the actual person or item. *Id.* In contrast, *Bellinger* discloses a processing system for imaging large groups of checks. *See Bellinger*, at Abstract. The imaging of checks in *Bellinger* takes place in batch processing that occurs at the end of an account statement cycle. *Id.* at column 11, lines 40-64. Even more remote from the other two references, *Grant* discloses techniques for reducing customer transaction time at an ATM by allowing peripheral devices to operate concurrently. *Grant*, Abstract. After examining the references, Applicants can discern no relationship between *Bellinger's* check imaging system, *Schwab's* secure identification technique, and *Grant's* ATM efficiency concepts. Applicants respectfully submit that these three references are non-analogous.

For at least these reasons, Applicants request reconsideration and withdrawal of the rejection.

Statement of Substance of Interview

Applicants thank the Examiners for the telephone interview conducted on April 10, 2007. During the interview, Applicants' representative and the Examiners discussed the history of the application and distinctions of the claims from the cited references. No agreements were reached.

CONCLUSION

Applicants have made an earnest attempt to place the Application in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of the Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

Applicants believe that no other fees are due. However, the Commissioner is hereby authorized to charge any appropriate fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants

A handwritten signature in black ink, appearing to read 'Kurt M. Pankratz', with a stylized flourish at the end.

Kurt M. Pankratz
Reg. No. 46,977

Date: April 23, 2007

Customer No. **05073**